

09/509438

705/72339-2 (8290)

430 R [REDACTED] PCT/PTO 28 MAR 2000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	PATENT
)	
Mats LEIJON et al.)	Group: To Be Assigned
)	
Serial No: New Application)	Examiner: To Be Assigned
Based on PCT/SE98/01736)	
)	
Filed: March 28, 2000)	
)	
SYNCHRONOUS COMPENSATOR)	
PLANT)	

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1-24-01*

INFORMATION DISCLOSURE STATEMENT
SUBMITTED WITHOUT COPIES OF INFORMATION
DISCLOSURE STATEMENT CITATIONS PURSUANT TO
DECISION ON PETITION UNDER 37 C.F.R. 1.183
SEEKING WAIVER OF REQUIREMENTS UNDER 37
C.F.R. 1.98

Assistant Commissioner for Patents
Washington, D.C. 20231

Washington, D.C.
March 28, 2000

Sir:

Pursuant to 37 C.F.R. §1.56, the attention of the Patent and Trademark Office is hereby directed to the reference(s) listed on the attached PTO Form-1449. Copies of the references were filed in the office of Examiner Gelner with a petition dated September 27, 1999.

The above information is presented so that the Patent and Trademark Office may, in the first instance, determine any materiality thereof to the claimed invention. See 37 C.F.R. §§1.104(a) and 1.106(b) concerning the PTO duty to consider and use any such information. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the reference(s) be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

Pursuant to the Decision on Petition dated December 1, 1999, which was filed in U.S. Patent Application No. 09/147,325 (the holding application), the requirement for the submission of a copy of each Information Disclosure Statement citation is waived provided that the conditions set forth in paragraphs 1-8 (pages 8-10) of the Decision on Petition are met.

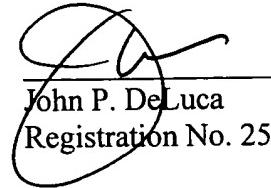
The conditions set forth in the Decision on Petition are believed to have been met as follows:

1. Three paper copies of each Information Disclosure Statement citation were supplied to the U.S. Patent and Trademark Office.
2. This application (the bulk filing application) for which the waiver is desired is related to the above identified holding application U.S. Patent Application No. 09/147,325.
3. The information herein has been cited in the above holding application
4. A copy of the Decision on Petition granting the waiver is attached hereto.
5. At present, no explanatory information related to any particular citation has been submitted in the holding application.
6. As of the time of this filing, the office has not terminated the waiver grant, nor has the applicant terminated or withdrawn its assent to the waiver.
7. The holding application is co-pending herewith.

The paper copies of the references cited herein are believed to be contained in a series of official digests established by the Office which is noted in the Decision On Petition.

If additional fees are required, please charge Deposit Account No 23-0575.

Respectfully submitted,


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Registration No. 25,505

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09/509438

INFORMATION DISCLOSURE CITATION LIST
ALTERNATE FORM PTM-149
(Corrected Listing of Original List)

Docket Number:

Applicant(s):

Filing Date:

Group Art Unit:

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
1		US1304451	5/20/19	L. H. Burnham			
2		US1418856	6/2/22	Robert B. Williamson			
3		US1481585	1/22/24	James Robert Beard			
4		US1728915	9/24/29	E. P. Blankenship et al			
5		US1742985	1/7/30	L. H. Burnham			
6		US1747507	2/18/30	Robert B. George			
7		US1756672	4/29/30	John M. Barr			
8		US1762775	6/10/30	Albert G. Ganz			
9		US1781308	11/11/30	Mauritz Vos			
10		US1861182	5/31/32	F. Hendey et al			
11		US1974406	9/25/34	Vincent G. Apple et al			
12		US2006170	6/25/35	Gustof A. Juhlin			
13		US2206856	7/2/40	W. E. Shearer			
14		US2217430	10/8/40	R. A. Baudry			
15		US2241832	5/13/41	H.W. Wahlquist			
16		US2251291	8/5/41	L. O. Reichelt			
17		US2256897	9/23/41	W. F. Davidson et al			
18		US2295415	9/8/42	G.R. Monroe			
19		US2415652	2/11/47	R. B. Norton			
20		US2424443	7/22/47	B. C. Evans			
21		US2436306	2/17/48	J. S. Johnson			
22		US2446999	8/17/48	G. Camilli			
23		US2459322	1/18/49	G. T. Johnston			
24		US2462651	2/22/49	H. W. Lord			
25		US2498238	2/21/50	L. J. Berberich et al			
26		US2721905	10/25/55	D. J. Monroe			
27		US2780771	2/5/57	B. Lee			
28		US2846599	8/5/58	H. H. McAdam			
29		US2885581	5/5/59	P. T. Pileggi			
30		US2943242	6/28/60	E. Schaschl et al			
31		US2947957	8/2/60	J. C. Spindler			
32		US2959699	11/8/60	J. W. Smith et al			
33		US2962679	11/29/60	J. L. Stratton			
34		US2975309	3/14/61	M. Seidner			
35		US3098893	7/23/63	R. A. Pringle et al			
36		US3130335	4/21/64	L. J. Rejda			
37		US3143269	8/4/64	J. Van Eldik			
38		US3157806	11/17/64	E. Wiedemann			
39		US3158770	11/24/64	A. D. Coggeshall et al			
40		US3268766	8/23/66	S. E. Amos			
41		US3304599	2/21/67	R. W. Nordin			
42		US3354331	11/21/67	H. L. Broeker et al			
43		US3365657	1/23/68	James Webb			
44		US3372283	5/5/68	A. A. Jaecklin			

Examiner

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ALTERNATE FORM PTO-1449
 (Corrected Listing of Original List)

	45	US3418530	11/24/68	W. H. Cheever			
	46	US3435262	3/25/69	R. B. Bennett et al			
	47	US3437858	4/8/69	R. B. White			
	48	US3444407	5/13/69	E.S. Yates			
	49	US3447002	5/27/69	C. Ronnevig			
	50	US3484690	12/16/69	H. Wald			
	51	US3560777	2/2/71	W. Moeller			
	52	US3593123	7/13/71	A. C . Williamson			
	53	US3631519	12/28/71	H. Salahshourian			
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	55	US3651402	3/21/72	P. H. Leffmann			
	56	US3670192	6/13/72	A. A. Andersson et al			
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	66	US3781739	12/25/73	L. Meyer			
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	72	US3891880	6/24/75	H. Britsch			
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	74	US3932779	1/13/76	A. Madsen			
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	77	US3947278	3/30/76	K. Youtsey			
	78	US3965408	6/22/76	H. Higuchi et al			
	79	US3968388	7/6/76	D. Lambrecht et al			
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	81	US3974314	8/10/76	H. Fuchs			
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	87	US4041431	8/9/77	G. Enoksen			
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	89	US4064419	12/20/77	R. Peterson			
	90	US4084307	4/18/78	G. Schultz el al			
	91	US4085347	4/18/78	K. Lichius			
	92	US4088953	5/9/78	S. Sarian			
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	94	US4091139	5/23/78	J. Quirk			
	95	US4099227	7/4/78	J. Liptak			

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96	US4103075	7/25/78	E. Adam
97	US4106069	8/8/78	J. Trautner et al
98	US4107092	8/15/78	R. Carnahan et al
99	US4109098	8/22/78	M. Olsson et al
100	US4121148	10/17/78	H. Platzer
101	US4134036	1/9/79	G. Curtiss
102	US4134055	1/9/79	M. Akamatsu
103	US4134146	1/9/79	E. Stetson
104	US4149101	4/10/79	A. Lesokhin et al
105	US4152615	5/1/79	R. Calfo et al
106	US4160193	7/3/79	A. Richmond
107	US4164672	8/14/79	C. Flick
108	US4164772	8/14/79	N. Hingorani
109	US4177397	12/4/79	John Lill
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111	US4184186	1/15/80	P. Barkan
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122	US4246694	1/27/81	H-G Raschbichler et al
123	US4255684	3/10/81	W. Mischler et al
124	US4258280	3/24/81	M. Starcevic
125	US4262209	4/14/81	C. Berner
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128	US4307311	12/22/81	A. Grozinger
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132	US4317001	2/23/82	D. Silver et al
133	US4320645	3/23/82	L. Stanley
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136	US4337922	7/6/82	M. Streiff et al
137	US4341989	7/27/82	T. Sandberg et al
138	US4347449	8/31/82	J. F. Beau
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140	US4363612	10/12/82	R. Meyers
141	US4357542	11/2/82	H. Kirschbaum
142	US4360748	11/23/82	H-G Raschbichler et al
143	US4367425	1/4/83	M. Mendelsohn et al
144	US4368418	1/11/83	F. P. Demello et al
145	US4369389	1/18/83	D. Lambrecht
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(Corrected Listing of Original List)

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148	US4403163	9/6/83	Rarmerding et al			
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150	US4411710	10/25/83	M.Mochizuki et al			
151	US4421284	12/20/83	A. Pan			
152	US4425521	1/10/84	G. Rosenberry, Jr. et al			
153	US4426771	1/24/84	D. Wang et al			
154	US4429244	1/31/84	P. Nikiten et al			
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157	US4470884	9/11/84	D. Carr			
158	US4473765	9/25/84	T. Butman, Jr. et al			
159	US4475075	10/2/84	R. Munn			
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161	US4481438	11/6/84	T. Keim			
162	US4488079	12/11/84	G. Dailey et al			
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164	US4510077	4/9/85	R. Elton			
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166	US4523249	6/11/85	S. Arimoto			
167	US4538131	8/27/85	M. Baier et al			
168	US4546210	10/8/85	Y. Akiba et al			
169	US4551780	11/5/85	M. Canay			
170	US4557038	12/10/85	M. Wcislo et al			
171	US4560896	12/24/85	G. Vogt et al			
172	US4565929	1/21/86	J. Baskin et al			
173	US4588916	5/13/86	R. Lis			
174	US4590416	5/20/86	M. Porche et al			
175	US4594630	6/10/86	M. Rabinowitz et al			
176	US4607183	8/19/86	J. Rieber et al			
177	US4615109	10/7/86	M. Wcislo et al			
178	US4618795	10/21/86	G. Cooper et al			
179	US4619040	10/28/86	D. Wang et al			
180	US4633109	12/30/86	J. Feigel			
181	US4650924	3/17/87	J. Kauffman et al			
182	US4656379	4/7/87	F. McCarty			
183	US4677328	6/30/87	K. Kumakura			
184	US4687882	8/18/87	G. Stone et al			
185	US4692731	9/8/87	H. Osinga			
186	US4723104	2/22/88	F. Rohatyn			
187	US4737704	4/12/88	S. Kalinnikov et al			
188	US4745314	5/17/88	J. Nakano			
189	US4766365	8/23/88	L. Bolduc et al			
190	US4785138	11/15/88	O. Brietenbach et al			
191	US4795933	1/3/89	K. Sakai			
192	US4827172	5/2/89	K. Kobayashi			
193	US4845308	7/4/89	E. Womack, Jr. et al			
194	US4847747	7/11/89	A. Abbondanti			
195	US4853565	8/1/89	R. Elton et al			
196	US4859810	8/22/89	R. Cloetens et al			
197	US4860430	8/29/89	H. Raschbichler et al			

Examiner	Date Considered
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ALTERNATE FORM PTO-1449
 (Corrected Listing of Original List)

	198	US4864266	9/5/89	L. Feather et al			
	199	US4883230	11/28/89	L. Lindstrom			
	200	US4894284	1/16/90	S. Yamanouchi et al			
	201	US4914386	4/3/90	S. Zocholl			
	202	US4918347	4/17/90	Y. Takaba			
	203	US4918835	4/24/90	H. Wcislo et al			
	204	US4924342	5/8/90	R. Lee			
	205	US4926079	5/15/90	P. Niemela et al			
	206	US4942326	7/17/90	J. Butler, III et al			
	207	US4949001	8/14/90	S. Campbell			
	208	US4994952	2/19/91	D. Silva et al			
	209	US4997995	3/5/91	M. Simmons et al			
	210	US5012125	4/30/91	D. Conway			
	211	US5036165	7/30/91	R. Elton et al			
	212	US5036238	7/30/91	M. Tajima			
	213	US5066881	11/19/91	R. Elton et al			
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	215	US5083360	1/28/92	M. Valencic et al			
	216	US5086246	2/4/92	J. Dymond et al			
	217	US5094703	3/10/92	M. Takaoka et al			
	218	US5097241	3/17/92	E. Smith et al			
	219	US5097591	3/24/92	M. Wcislo et al			
	220	US5111095	5/5/92	J. Hendershot			
	221	US5124607	6/23/92	J. Rieber et al			
	222	US5136459	8/4/92	D. Fararooy			
	223	US5140290	8/18/92	H. Dersch			
	224	US5153460	10/6/92	L. Bovino et al			
	225	US5168662	12/8/92	K. Nakamura et al			
	226	US5187428	2/16/93	R. Hutchison et al			
	227	US5235488	8/10/93	S. Koch			
	228	US5246783	9/21/93	L. Spenadel et al			
	229	US5264778	11/23/93	D. Kimmel et al			
	230	US5304883	4/19/93	J. Denk			
	231	US5305961	4/26/93	A. Errard et al			
	232	US5321308	6/14/93	A. Johncock			
	233	US5323330	6/21/93	G. Asplund et al			
	234	US5325008	6/28/94	J. Grant			
	235	US5327637	7/12/94	O. Britenbach et al			
	236	US5341281	8/23/94	G. Skibinski			
	237	US5343139	8/30/94	L. Gyugyi et al			
	238	US5355046	10/11/94	K. Weigelt			
	239	US5365132	11/15/94	J. Hann et al			
	240	US5387890	2/7/95	P. Estop et al			
	241	US5397513	3/14/95	C. Steketee, Jr.			
	242	US5400005	3/21/95	H. Bobry			
	243	US5452170	9/19/95	S. Ohde et al			
	244	US5468916	11/21/95	M. Litenas et al			
	245	US5500632	3/19/96	J. Halser, III			
	246	US5510942	4/23/96	L. Bock et al			
	247	US5530307	6/25/96	G. Horst			
	248	US5545853	8/13/96	N. Hildreth			

Examiner

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ALTERNATE FORM PTO-1449
(Corrected Listing of Original List)

249	US5550410	8/27/96	C. Titus			
250	US5583387	12/10/96	M. Takeuchi et al			
251	US5587126	12/24/96	C. Steketee, Jr.			
252	US5598137	1/28/97	F. Alber et al			
253	US5607320	3/4/97	J. Wright			
254	US5612510	3/18/97	N. Hildreth			
255	US5663605	9/2/97	P. Evans et al			
256	US5672926	9/30/97	J. Brandes et al			
257	US5689223	11/18/97	A Demarmels et al			
258	US5807447	9/15/98	I. Forrest			
259	US681800	9/3/01	O. Lasche			
Subtotal:	259					

FOREIGN PATENT DOCUMENTS

	DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION	
				YES	NO
1	AT399790	7/25/95	Austria		
2	BE565063	2/23/57	Belgium		
3	CH391071	4/30/65	Switzerland		
4	CH534448	2/28/73	Switzerland		
5	CH539328	7/4/73	Switzerland		
6	CH657482	8/29/86	Switzerland		
7	DD137164	8/15/79	Germany DDR		
8	DD138840	11/21/79	Germany DDR		
9	DE1638176	6/24/71	Germany		
10	DE1807391	5/27/70	Germany		
11	DE2050674	5/19/71	Germany		
12	DE2155371	5/17/73	Germany		
13	DE2400698	7/10/75	Germany		
14	DE2520511	11/18/76	Germany		
15	DE2656389	6/15/78	Germany		
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17	DE277012	7/25/14	Germany		
18	DE19547229	6/19/97	Germany		
19	DE2824951	12/20/79	Germany		
20	DE2835386	2/21/80	Germany		
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22	DE2854520	6/26/80	Germany		
23	DE2913697	10/16/80	Germany		
24	DE2917717	8/20/87	Germany		
25	DE2920478	12/4/80	Germany		
26	DE2939004	4/9/81	Germany		
27	DE3006382	8/27/81	Germany		
28	DE3008818	9/10/81	Germany		
29	DE3009102	9/25/80	Germany		
30	DE3028777	3/26/81	Germany		
31	DE3305225	8/16/84	Germany		
32	DE3309051	9/20/84	Germany		
33	DE336418	6/23/20	Germany		
34	DE3441311	5/15/86	Germany		

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	35	DE3543106	6/11/87	Germany		
	36	DE3612112	10/15/87	Germany		
	37	DE372390	3/27/23	Germany		
	38	DE3726346	2/16/89	Germany		
	39	DE387973	1/9/24	Germany		
	40	DE4022476	1/16/92	Germany		
	41	DE4023903	11/7/91	Germany		
	42	DE40414	8/15/1887	Germany		
	43	DE4233558	3/31/94	Germany		
	44	DE425551	2/20/26	Germany		
	45	DE426793	3/18/26	Germany		
	46	DE432169	7/26/26	Germany		
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	85	EP0335430	10/4/89	European		

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	38	OD039	Thin Type DC/DC Converter using a coreless wire transformer; K. Onda et al; Proc. IEEE Power Electronics Spec. Conf.; 6/1994, pp330-334
	39	OD040	Development of extruded polymer insulated superconducting cable; 1/1992
	40	OD041	Transformer core losses; B. Richardson; Proc. IEEE 5/1986, pp365-368

Examiner

Date
Considered

*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

ALTERNATE FORM PTO-1449
(Corrected Listing of Original List)

	41	OD042	Cloth-transformer with divided windings and tension annealed amorphous wire; T. Yammamoto et al; IEEE Translation Journal on Magnetics in Japan Vol 4, No. 9 Sept. 1989
	42	OD043	A study of equipment sizes and constraints for a unified power flow controller; J Bian et al; IEEE 1996
Subtotal	43		
GRAND TOTAL	671		

Examiner

Date
Considered

*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEPO 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

INFORMATION DISCLOSURE CITATION LIST ALTERNATE FORM PTO-1449 Issue 2: dated 02/21/00	Docket Number:	Application Number 09/509438
	Applicant(s):	
	Filing Date:	Group Art Unit:

U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
1	US 4,292,558	9/29/1981	Carl Flick et al			
2	US 4,656,316	4/7/1987	Hans-Juergen Meltsch			
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Examiner	Date Considered
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*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEPO 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

09/509438

Issue 2, dated 02/21/00

428 Rec'd PCT/PTO 28 MAR 2000

FOREIGN PATENT DOCUMENTS

	DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION
				YES NO
1	GB 1,319,257	6/6/1973	Anders R. Andersson et al	
2	GB 1,322,433	7/4/1973	Siemens Aktiengesellschaft	
3	GB 2,070,341	9/3/1981	Hans-Georg Raschbichler et al	
4	WO 98/20598	5/14/1998	Jan-Anders Karlfeldtsgatan et al	
5	WO 98/20602	5/14/1998	Soren Berggren	
6	WO 98/34239	8/6/1998	Gunnar Steneorpsgatan et al	
7	WO 99/28922	6/10/1999	Thorsten Schutte et al	
8	WO 99/29005	6/10/1999	Mats Leijon et al	
9	WO 99/29023	6/10/1999	Peter Carstensen et al	
10	WO 99/29025	6/10/1999	Mats Leijon et al	
11	EP 0056580 A1	7/28/1982	Jacobus F.H. Van der Vegt	
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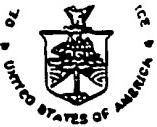
Subtotal

Examiner

Date
Considered

*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

09/509438



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

430 Rec'd PCT/PTO 28 MAR 2000

TJL
12/3/99

RESPONSE TO DECISION
2-1-00

Paper No. 11

COPY MAILED

DEC 01 1999

SPECIAL PROGRAMS OFFICE
DAB FOR PATENTS

Oblon Spivak McClelland Maier & Neustadt
1755 Jefferson Davis Highway
Fourth Floor
Arlington VA 22202

In re Application of
Mats Leijon, et al
Application No. 09/147,325
Filed: February 17, 1999
Attorney Docket No. 9847-0001-
6X

: RESPONSE TO PETITION UNDER
: 37 CFR 1.182 SEEKING SPECIAL
: TREATMENT RELATING TO AN
: ELECTRONIC SEARCH TOOL, AND
: DECISION ON PETITION UNDER
: 37 CFR 1.183 SEEKING WAIVER
: OF REQUIREMENTS UNDER 37 CFR
: 1.98

This is a response to a September 29, 1999 Petition Under 37 CFR 1.182, requesting relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98 in view of the need to file multiple applications relating to different aspects of a particular invention. The petition will be treated as two separate petitions: a first petition under 37 CFR 1.182, relating to submission of an electronic search tool and the need to protect proprietary information therein, and a second petition under 37 CFR 1.183, requesting relief from the § 1.98 provision which requires filing paper copies of references being cited in each of many related applications.

A Decision on the petition under 37 CFR 1.182 re the electronic search tool will be issued in due course.

The petition under 37 CFR 1.183 re the submission of 3 paper copies of IDS citations in a holding application is Granted to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Electronic Search Tool
- Part III. Petition Under 37 CFR 1.183 - Paper Copies

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OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT P.C.

- Part IV. Summary
- Part V. Further Correspondence

Part I. Background

The instant national stage application filed under 35 U.S.C. 371 currently contains claims 77-153 with three independent claims. The instant application is one of about 200 U.S. applications (either filed or to be filed) with each U.S. application having as many as 40 corresponding foreign applications (either filed or to be filed), the applications relating to different aspects of the invention. An Information Disclosure Citation List has been submitted that lists 259 U.S. patents, 369 foreign patent documents, and 43 other references for a total of 671 citations. Additionally, a list of related cases has been supplied containing 31 U.S. applications and 52 PCT applications. Paper copies have not been supplied in the related applications of any of the citations or the identified related cases.

37 CFR 1.56(b)(1) requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98. 37 CFR 1.56(a).

Petitioner asks "[w]hether the information cited in the manner proposed in [petition] Section 3.1.1 ... is a disclosure that is sufficient to meet the requirements of 37 CFR § 1.56." To the extent that this question refers to the content of the disclosure and the particulars of the subject applications, the Office will not answer the question. It is Office practice not to attempt to define how an individual "ensures" compliance with the rule in a particular application. See, e.g., MPEP 2004. Because determinations on this issue require an evaluation of the intent of the party involved, the Office declines to investigate the question. See MPEP 2010. To the extent that Petitioner's question concerns the form in which the disclosure is provided, rule 56 permits a disclosure in a combination of paper and electronic formats.

Petitioner, in addition to meeting the duty set forth in 37 CFR 1.56 to disclose material information, also wishes to disclose to the Office information that may not meet the definition of

materiality as set forth in the rule¹. Information identified by U.S. or foreign examiners in any of the related U.S. and foreign applications would be cited in each of the related U.S. applications.² In addition, Petitioner seeks to submit other information in each of the related U.S. applications, such as all the co-pending U.S. applications that relate to the invention (useful for determining possible double patenting rejections), and foreign search reports. Petition, page 4.

Rather than be required to submit, via a paper copy, each piece of information in each application each time the information is obtained, Petitioner seeks to have:

(1) (a) one application (the instant application) identified as a "holding" application which would contain a complete set of paper copies of references; the paper copies to be submitted in only the "holding" application;

(b) the other related pending U.S. applications, hereafter referred to as the bulk filing applications, will not contain the paper set of reference copies but will contain other information, e.g., a copy of the decision on petition³ permitting such procedure and a copy of the Form 1449 (or equivalent);⁴ and

(2) an "electronic search tool"⁵ containing different types of information.

The information supplied via the paper copies would be updated monthly, rather than as received from U.S. and foreign examiners, and cancellation of this arrangement would be an option for both

¹Reference to MPEP 2001.05, Petition, page 3.

²Petition, page 3. The present petition requesting relief does not set forth any commitment nor intent by applicant to screen such information for relevancy to each of the U.S. applications in which the information is being cited.

³The original of which would be in the instant holding application.

⁴See, Petition under 37 CFR 1.182, *infra*.

⁵See, Petition under 37 CFR 1.183, *infra*.

Petitioner and the Office upon notice. These, and other more specific conditions, are discussed in further detail in regard to the § 1.182 petition, below.

Petitioner has essentially requested relief in two areas: (1) treatment of information in an electronic search tool, to be submitted independent of any particular application, as in compliance with IDS submission requirements for all bulk filing applications, and (2) the ability to provide the paper copies of each reference in an IDS submission in only one of the bulk filing applications (the instant holding application) as well as two additional sets of copies rather than as is normally required in each application for which the reference (IDS citation) is to be considered. These two areas of relief are independent of each other and drawn toward different regulations. Accordingly, the petition has been treated as two petitions, and the present decision addresses the two areas of requested relief separately. While it is undeniable that relief in both areas would be of benefit to Petitioner, the granting of relief in one area does not, in fact, require the granting of relief in the other. Moreover, in view of the need to further consider the requested relief related to the electronic search tool, deciding the requested relief issues separately permits at this time a partial grant of the original petition.⁶

Part II. Petition under 37 CFR 1.182- Electronic Search Tool

The issues involving the electronic search tool are more extensive than those relating to the requirement for paper copies in each bulk filing application and more time is needed to fully consider and address them. Accordingly, the petition under § 1.182 shall not be decided at this time and is not treated in the instant decision on the § 1.183 petition although it will continue to be considered, with a decision rendered in due course.

⁶It is recognized that petitioner believes the issues presented by the petition may not be decided independent of one another as both the paper copy issue and the electronic search tool issue represent the most complete solution to duty ~~of~~ disclosure issues under 37 CFR 1.56, Petition, fn. 5. : =

Part III. Petition Under 37 CFR 1.183 - Paper Copies

The submitted petition fee of \$130 will be treated as the § 1.183 petition fee.

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, page 600-102, right-hand column, and page 600-103, left-hand column.

Paper copies: Petitioner notes that the instant application is one of 200 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each reference, brought to the attention of the Office in regard to any one individual application, not be required to be submitted in each such application. Rather, it is requested that three complete sets of paper copies be permitted to be filed: one set for the instant application which will be designated as a holding application; one set to be used to establish new subclasses for the technology; and one set to be used as a reference set should either or both of the other two sets become corrupted (Petition, pages 6 and 7).⁷

Once past the initial IDS submission, it is proposed that applicant would update the IDS submissions once a month, rather than every time a new reference is found, although the time frames required by § 1.97 would have to be complied with, which may mean that submissions may occur more frequently than once a month.

Form 1449: In addition to submission of the three sets of paper copies in the instant "holding" application, the petition proposes that each of the bulk filing applications would receive a Form 1449 listing the reference citations (Petition, page 7) and the Form 1449 (in each of the bulk filing applications) would be updated, pursuant to the time requirements of § 1.97, each time the three sets of paper copies are updated. The petition is

⁷It would presumably up to the Technology Center to determine how best to store the reference set and how it's to be accessed.

silent as to whether other types of information that may be submitted in the holding application IDS, e.g., concise explanations of foreign language documents under § 1.98(a)(3), would also be supplied in all the bulk filing applications.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies), the petition states that upon allowance of the instant holding application the right is reserved to file a petition to suspend action in the instant application so that the application can remain as the holding application (Petition, page 7). Alternatively, upon agreement of the Assignee and a Director of the Technology Center involved, an alternate application may be designated as the holding application.

New subclasses: The petition envisions an affirmative duty on the Technology Center to establish new subclasses that will include each of the references submitted during the course of prosecution of the bulk filing applications.⁸ In addition, the Office is to agree that "[e]xaminers will be required to search these newly created subclasses" (from submissions by the Assignee and later by others) "as part of the routine patent prosecution process." Petition, page 8.

Termination: Petitioner seeks a right of termination,⁹ which is to be a mutual option. Termination is to be by written notice, to the attorney of record if the Office terminates and the filing of a termination request and by contacting the Director of TC 2800 if applicant terminates. Conventional IDS procedures would begin three months after notice of termination.

⁸The new subclasses will later be supplemented by references supplied by others who may file applications related to the same technology.

⁹Although termination is discussed under a section related to licensing of the electronic search tool and the petition generally (Petition, pages 10 and 11), it is presumed that Petitioner intends to have the termination provision apply to the waiver of paper copies if that alone is granted.

37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of references in 200 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications,¹⁰ on balance, there is seen to be sufficient benefit to justify waiver in this instance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.¹¹

¹⁰Even though the technology of the applications may be related, the specific claims of the applications may require different classifications of the applications and the quantity of applications would dictate the need for more than one examiner to timely examine the applications.

¹¹The waiver being granted in this instance is not intended to set a general precedent where there is more than one application containing related subject matter. The Office, however, intends to use the instant grant to study whether the opportunity for waiver can be extended to other applicants in similar circumstances, and whether a more general program can be announced. One factor that will be considered is the extent to which relevant information (that may not be necessarily required by § 1.56(b) but which would nonetheless be useful to the examiner, e.g., § 1.56(a)(1) and (2)), is submitted rather than huge dumps of nonrelevant or marginally relevant information.

It is noted that while the petition only refers to the submission of citations that are made by both U.S. and foreign examiners, the term "include" is used (Petition, page 2) which is open ended. The Petition states that it is the intention to submit a copy of every reference identified both by U.S. examiners in the 200 U.S. applications and by foreign examiners in as many as 40 corresponding foreign applications for each U.S. application (Petition, page 3). It has not been stated whether the current 671 reference citations currently of record represent only those citations made by U.S. and foreign examiners or whether they include citations from other sources, such as a

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing application provided that the following conditions are complied with:

- 1) Three paper copies of each IDS citation are or have been submitted to the Office;
- 2) The (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;
- 3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

- 4) A copy of this Decision is filed in the bulk filing application;
- 5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.
- 6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would

preexamination search or third party citations. See also Petition, page 19.

have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

- 7) The grant of the § 1.183 petition re § 1.98(a)(2) does not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications,¹² or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.
- 8) The Office has established a series of Official Digests in Class 174 based on the technology represented by the instant invention (a classification schedule thereof is attached). As is the case will all Digests, their usefulness will be continually evaluated. The Office will place the holding application's references in the Digests as they are determined to require such placement and as new ones are brought to the attention of the Office either by Petitioner or a third party. A search of the Digests themselves or what they contain (such as the holding application or reference copy sets), either in paper copy or electronic form, will be

¹²The patent file can be kept in the Technology Center for easy reference, or rather than rely upon the patent, either the reference set of paper copies could be utilized, or the Office may decide to rely on the Digests being created.

conducted when mandatory based on the classification of the claims, or when deemed advisable - on a case by case basis.

Part IV. Summary

A Decision on the Petition under 37 CFR 1.182, drawn toward submission of the electronic search tool, will be acted upon in due course when all outstanding issues are resolved.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted, however, the following is not agreed to:

- the grant of a future petition under 37 CFR 1.103 for suspension from publication of the holding application should it be allowed,
- the required search of subclasses from one of the three sets of paper copies and placement of one of the other sets of paper copies therein, and
- any termination provision more than two months (rather than the three months that the petition sets forth) from notice of termination.

Part V. Further Correspondence

Further correspondence with respect to this matter should be addressed to Hiram H. Bernstein, Senior Legal Advisor, Special Program Law Office, as follows:

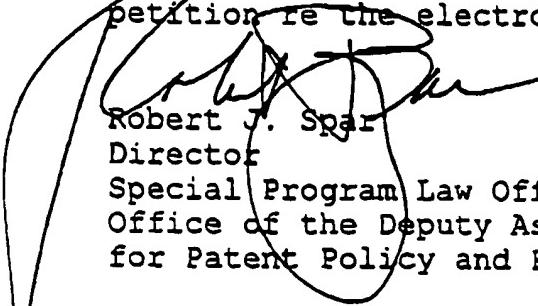
By mail: Commissioner of Patents and Trademarks
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Special Program Law Office

By hand: Special Program Law Office
 Crystal Plaza Four, Suite 3C23
 2201 South Clark Place
 Arlington, VA 22202

Telephone inquiries specific to this matter should be directed to Mr. Bernstein at (703) 305-9285.

The instant application will be retained by this Office: for a period of TWO MONTHS to await any response to the instant Decision, and for the purpose of continuing review of the S 1.182 petition re the electronic search tool.


Robert J. Spar
Director
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

Attachment: List of Digests 13-33

- Digest 13 **HIGH VOLTAGE CABLE (E.G., ABOVE 10KV, CORONA PREVENTION, ETC.)**
- Digest 14 . Having a particular cable application (e.g., winding, etc.)
- Digest 15 .. In a power generation system (e.g., prime-mover dynamo, generator system, etc.)
- Digest 16 .. In a motive power system (e.g., electric motor control system, etc.)
- Digest 17 .. In an electric power conversion, regulation, or protection system
- Digest 18 .. In a power distribution network
- Digest 19 .. In a dynamo-electric machine
- Digest 20 ... Stator
- Digest 21 ... Rotor
- Digest 22 ... Winding, per se
- Digest 23 .. In a circuit breaker, relay, or switch
- Digest 24 .. In an inductive device (e.g., reactor, electromagnet, etc.)
- Digest 25 ... Transformer
- Digest 26 . Having a plural-layer insulation system
- Digest 27 .. Including a semiconductive layer
- Digest 28 ... Plural semiconductive layers
- Digest 29 . Having a semiconductive layer
- Digest 30 . Having insulation with a particular dimension or geometry
- Digest 31 . Having a shield or metallic layer
- Digest 32 . Having means for cooling
- Digest 33 . Method of cable manufacture, assembly, repair, or splicing